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(Also referred to as FORM PTO - 1465)

REQUEST FOR *INTER PARTES* REEXAMINATION TRANSMITTAL FORM

Address to:

Mail Stop *Inter* Partes Reexam
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attorney Docket No. 17242US01

Date: January, 23, 2006

1. ☒ This is a request for *inter partes* reexamination pursuant to 37 CFR 1.913 of patent number 6,838,618 issued January 4, 2005. The request is made by a third party requester, identified herein below.

2. ☒ a. The name and address of the person requesting reexamination is:
Genlyte Group, Inc.
10350 Ormsby Park Place, Suite 601
Louisville, KY 40223

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ROYLANCE, ABRAMS
BERDO & GOODMAN, L.L.P.
BY AMB

☒ b. The real party in interest (37 CFR 1.915(b)(8)) is: Genlyte Group, Inc.

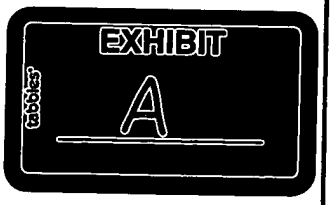
3. ☐ a. A check in the amount of $_____ is enclosed to cover the reexamination fee, 37 CFR 1.20(c)(2); or
☒ b. The Director is hereby authorized to charge the fee ($8,800.00) as set forth in 37 CFR 1.20(c)(2) to Deposit Account No. 13-0017 (submit duplicate of this form for fee processing); or
☐ c. Payment by credit card. Form PTO-2038 is attached.

4. ☒ Any refund should be made by ☐ check or ☒ credit to Deposit Account No. 13-0017. 37 CFR 1.26(c). If payment is made by credit card, refund must be to credit card account.

5. ☒ A copy of the patent to be reexamined having a double column format on one side of a separate paper is enclosed. 37 CFR 1.915(b)(5)

6. ☐ CD-ROM or CD-R in duplicate, Computer Program (Appendix) or large table
☐ Landscape Table on CD

7. ☐ Nucleotide and/or Amino Acid Sequence Submission
If applicable, items a. – c. are required.
a. ☐ Computer Readable Form (CRF)
b. Specification Sequence Listing on:
i ☐ CD-ROM (2 copies) or CD-R (2 copies); **or**
ii ☐ paper
c. Statements verifying identity of above copies



8. ☒ A copy of any disclaimer, certificate of correction or reexamination certificate issued in the patent is included.

9. ☒ Reexamination of claim(s) 1-4, 6-7, 10-17 and 20-21 is requested.

10. ☒ A copy of every patent or printed publication relied upon is submitted herewith including a listing thereof on Form PTO/SB/08, PTO-1449, or equivalent.

11. ☒ An English language translation of all necessary and pertinent non-English language patents or printed publications is included.

12. ☒ The attached detailed request includes at least the following items:
    a. A statement identifying each substantial new question of patentability based on prior patents and printed publication. 37 CFR 1.915(b)(3)
    b. An identification of every claim for which reexamination is requested, and a detailed explanation of the pertinency and manner of applying the cited prior art to every claim for which reexamination is requested. 37 CFR 1.915(b)(1) and (3)

13. ☒ It is certified that the estoppel provisions of 37 CFR 1.907 do not prohibit this reexamination. 37 CFR 1.915(b)(7)

14. ☒ a. It is certified that a copy of this request has been served in its entirety on the patent owner as provided in 37 CFR 1.33(c).
    The name and address of the party served and the date of service are:

    Jeffrey J. Howell, Alfred N. Goodman, attorneys of record; Roylance, Abrams, Berdo & Goodman, L.L.P.; 1300 19th Street, N.W., Suite 600, Washington, DC 20036

    William Y. Klett, III; Nexsen Pruet, LLC; Post Office Drawer 2426; Columbia, SC 29202-2426

    Date of Service: January 23, 2006; or

    ☐ b. A duplicate copy is enclosed since service on patent owner was not possible.

15. Correspondence Address : Direct all communication about the reexamination to:

☒ The address associated with Customer Number: 23,446

OR

☐ Firm or Individual Name					
Address					
City		State		Zip	
Country					
Telephone		Email			

16. ☒ The patent is currently the subject of the following concurrent proceeding(s):
    ☐ a. Copending reissue Application No. _____.
    ☐ b. Copending reexamination Control No. _____.
    ☐ c. Copending Interference No. _____.
    ☒ d. Copending litigation styled:
    Hubbell Inc. v. Genlyte Group, Inc. and Genlyte Thomas Group, LLC, 7:05-CV-02765 - HMH

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

James Nuttall — January 23, 2006

Authorized Signature For Third Party Requester — Date

James R. Nuttall — 44,978

Typed/Printed Name — Registration Number, if applicable

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Reexamination of: *Newbold et al.*

Control No.: _____

Filed: January 23 , 2006

U.S. Patent No.: 6,838,618

Issued: January 4, 2005

For: FIRE ASSEMBLY FOR RECESSED ELECTRICAL FIXTURES

CERTIFICATE OF MAILING

EXPRESS MAIL NO.: EV 164037425 US

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail in an envelope addressed to: Mail Stop *Inter* Partes Reexamination, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on January 23, 2006.

By: _____
James R. Nuttall
Reg. No. 44,978

REQUEST FOR *INTER PARTES* REEXAMINATION

Doc'd _____ File _____
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Mail Stop *Inter Partes* Reexam
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

JAN 26 2006
ROYLANCE, ABRAMS
BERDO & GOODMAN, L.L.P.
BY ANC

Sir:

Genlyte Group, Inc. ("Genlyte") hereby respectfully requests *inter partes* reexamination under 35 U.S.C. §§ 311-318 of United States Patent No. 6,838,618 ("the '618 patent"), which issued on January 4, 2005 to Newbold et al. The '618 patent is still enforceable. A copy of the '618 patent is submitted herewith as Exhibit A, in accordance with 37 C.F.R. § 1.510(b)(4).

I. CLAIMS FOR WHICH REEXAMINATION IS REQUESTED AND CITATION OF THE PATENTS AND PRINTED PUBLICATIONS THAT PROVIDE A SUBSTANTIAL NEW QUESTION OF PATENTABILITY

Reexamination is requested of claims 1-4, 6-7, 10-17, and 20-21 of the '618 patent, in view of U.K. Patent Application GB 2,326,467A to Ward (Exhibit B), U.S.

Patent No. 6,105,334 to Monson et al. (Exhibit C), Underwriters Laboratories Inc. 1991 Fire Resistance Directory (Exhibit D), U.S. Patent No. 4,910,651 to Montanez (Exhibit E), Hubbell Lighting 1992 Buyers Guide (Exhibit F), U.S. Patent No. 4,754,377 to Wenman (Exhibit G) and each alone or in combination with each other. The above references are newly applied, except for U.S. Patent No. 6,105,334. The latter patent has not previously been considered in conjunction with the prior art newly cited in this request.

II. STATEMENT OF SUBSTANTIAL NEW QUESTIONS OF PATENTABILITY

A. Overview

1. The '618 Patent

The '618 patent relates to fire resistant housings for recessed light fixtures. The applicants admitted in the background of the '618 patent that fire resistant housings for light fixtures were made well prior to the filing of the '618 patent application. (Ex. A, col. 1, lns. 51-63.) The applicants asserted during prosecution of the '618 patent, however, that the prior art did not disclose a fire resistant housing and light fixture that were preassembled prior to being put in the ceiling. The '618 patent describes and claims a light assembly with:

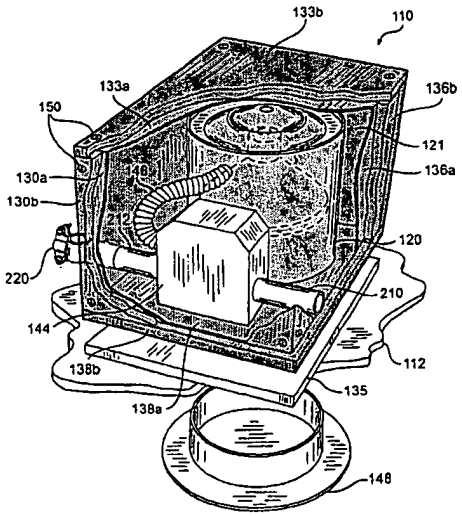


FIG. 3

- a light fixture (120);
- a housing having panels (130a, 133a, 136a, 138a);
- the housing includes a fire-resistant material (130b, 133b, 136b, 138b);
- the light fixture and housing form a preassembled integral unit; and

- the housing forms a substantially continuous surface with the ceiling.

2. Prior Art

Preassembled fire resistant housings and light fixtures were being built and sold years before the application for the '618 patent was filed. For example, Underwriters Laboratories published a Fire Resistance Directory in 1991 that describes the fabrication and assembly of a fire resistant housing light fixture together prior to installation in the ceiling. (Ex. D.) As shown on the left, the Ward patent which was filed in 1997 and published in 1998 also discloses a housing (7-12) that includes an intumescent fire proofing material[1] and light fixture that are a preassembled integral unit. (Ex. B.) The Wenman patent also discloses a light fixture reflector and socket assembly and a fire resistant housing that are a preassembled integral unit. (Ex. G, Figures 5 and 6, col. 3, ln. 53-col. 4, ln. 28.)

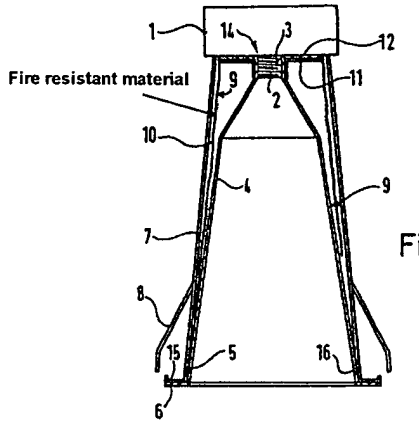
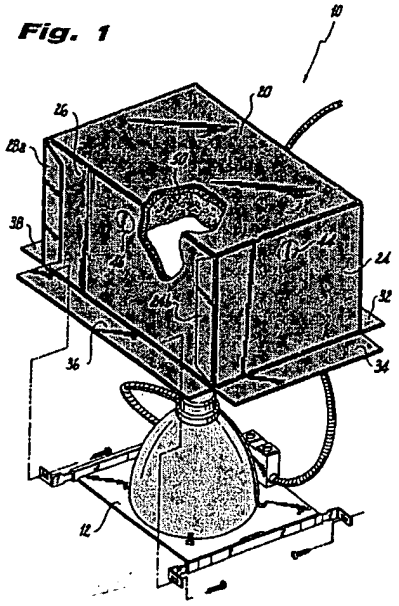


Fig.1.



The Monson patent also discloses a light fixture 12, a housing 10 that includes an intumescent fire proofing material 50, and the housing forms a substantially continuous surface with the ceiling. (Ex. C.) During prosecution of the '618 patent, the applicants admitted that the prior art Monson patent anticipated the claims of the '618 patent except for the housing and light fixture being a pre-assembled

[1] Hubbell contends that the intumescent fire proofing material in one of Genlyte's products is a fire resistant material as claimed in the '618 patent.

integral unit. (Ex. H.) The Examiner agreed that the prior art of record was not considered to show "in combination with the other claimed limitations of a light assembly comprising a housing substantially enclosing said light fixture, said housing and a light fixture forming a preassembled integral unit, said housing including at least one generally fire resistant material." (Id.)

Exhibits B and D clearly teach a preassembled integral housing (with fire proofing material) and a light fixture. Furthermore, preassembled integral housings and light fixtures have been made and sold in the recessed lighting industry, including by Hubbell Incorporated, the assignee of the '618 patent, for approximately 20 years. (*See e.g.*, Exs. E and F.) Therefore, numerous prior art references that were not reviewed during the prosecution of the '618 patent teach that it is obvious to form a light fixture and housing as a preassembled integral unit. Claims 1-4, 6-7, 10-17 and 20-21 of the '618 patent are therefore clearly obvious in view of Exhibits B-G.

Moreover, the prior art newly submitted herein raise § 102 issues of invalidity, not raised in the original prosecution of the '618 patent. Thus, there are no issues of cumulativeness. The questions of patentability raised herein have not been previously considered by the Examiner during the original prosecution.

It is submitted that claims 1-4, 6-7, 10-17, and 20-21 of the '618 patent are anticipated by or rendered obvious by the attached prior art references. These prior art patents and publications describe and disclose each and every element of claims 1-4, 6-7, 10-17, and 20-21 of the '618 patent. These patents, therefore, raise substantial new questions of patentability of the '618 patent.

III. ADDITIONAL INFORMATION

Hubbell Incorporated, the assignee of the '618 patent, has filed a complaint alleging that one of the requestor's products infringes the '618 patent, in a case captioned *Hubbell Incorporated v. Genlyte Group, Inc. and Genlyte Thomas Group, LLC*, 7:05-CV-02765-HMH. The '618 patent is a continuation of application no. 10/066,310 (still pending), which is a continuation-in-part of U.S. Patent No. 6,357,891.

IV. EXPLANATION OF PERTINENCE AND MANNER OF APPLYING CITED PRIOR ART TO EVERY CLAIM FOR WHICH REEXAMINATION IS REQUESTED

The cited prior art references anticipate or render obvious at least claims 1-4, 6-7, 10-17, and 20-21 of the '618 patent. As shown below, each claim element is anticipated or obvious in view of the attached prior art references.

A. The Ward Patent (GB 2,326,467) Anticipates And/Or Renders Obvious Claims 1-4, 6-7, 10-17, and 20-21

The Ward patent, not cited during prosecution of the '618 patent, relates to a light fixture "which includes an integral protective hood." (Ex. B, p. 2, lns. 1-2.) The Ward patent discloses that the protective hood includes an intumescent material to "maintain[] the fire resistance of the structure." (Ex. B, pgs. 4-5.) The Ward patent anticipates claims 1-4, 6-7, 10-17 and 20-21 (or renders obvious claims 3-4, 6, 11, 12, 14), and therefore raises a substantial new question of patentability of the '618 patent as shown in the following claim chart.

'618 Patent Claim 1	The Ward Patent
1. A light assembly comprising:	
a light fixture adapted to be positioned relative to an opening defined in a surface of a structure, and further adapted to allow light to	The Ward patent Figure 1 shows a recessed light fixture adapted to be positioned above an opening in the ceiling and to allow light to be projected through the opening. (Ex. B Figure 1;

be projected through said opening; and	*see also* p. 2, lns. 1-16.)
a housing substantially enclosing said light fixture,	The Ward patent discloses that "[p]ositioned about the external circumference of the reflector 4 is a hood 9." "As shown the hood 9 is frusto-conical and comprises an upstanding side wall 10 and top 11." (Ex. B, p. 4, lns. 1-7.)
said housing and said light fixture forming a preassembled integral unit,	The Ward patent discloses that the light fixture "includes an integral protective hood." (Ex. B, p. 2, lns. 1-3.)
said housing including at least one generally fire-resistant material,	The Ward patent discloses that "the hood 9 is produced from a fibrous woven cloth (e.g. a glass fibre woven cloth) which has been coated on one or both of its sides with an intumescent paint or other intumescent material." The Ward patent also discloses that "the intumescent coating of the hood 9... confin[es] the fire and any resulting smoke and maintain[s] the fire resistance of the structure." (Ex. B, p. 4, lns. 2-4; p. 4 ln. 27 - p. 5, ln. 5.)
said at least one generally fire-resistant material forming a substantially continuous surface with said surface of said structure.	The Ward patent discloses that "the hood 9 is formed at its lowermost end with an outwardly extending fabric piece 15 which locates on the upper surface of the downlighter lip 6. The fabric piece 15 may be secured to the lip 6." (Ex. B, p. 4, lns. 19-21.)
'618 Patent Claim 2	
2. A light assembly according to claim 1, wherein said structure includes a floor-ceiling assembly, said floor-ceiling assembly has a fire rating, and said housing is capable of substantially maintaining said fire rating after said light assembly is installed.	The Ward patent discloses that "in the event of such a fire, the intumescent coating of the hood 9... confin[es] the fire and any resulting smoke and maintain[s] the fire resistance of the structure." (Ex. B, p. 4, ln. 27 - p. 5 ln. 5.)
'618 Patent Claim 3	
3. A light assembly according to claim 1, wherein said housing includes a bottom wall and another wall, a portion of said bottom wall extending beyond an intersection of said bottom wall and said another wall of said housing,	Although the Ward patent does not disclose a junction box on the bottom wall, this is an obvious design choice. This is believed to be obvious because it has been done by those skilled in the art for approximately 20 years. (*See e.g.*, Exs. E and F.)

said portion having upper and lower surfaces and a junction box positioned on said upper surface of said portion.	
'618 Patent Claim 4	
4. A light assembly according to claim 3, wherein a gasket is positioned between said bottom wall and said surface of said structure.	As the Examiner found during prosecution of the '618 patent (and was not disputed by the applicants) that it was obvious to add a gasket on the bottom of the housing. (*See* Ex. H, 6/1/2004 Office Action at 8 ("Krebs teaches a light assembly comprising a light housing (50) and a second housing (12) surrounding said light housing (50) and a gasket (75) on the bottom wall of the second housing (see figure 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide to Monson's fire resistant housing with a gasket as taught by Krebs to prevent light leakage.").)
'618 Patent Claim 6	
6. A light assembly according to claim 1, wherein said housing further including a support structure formed from aluminum.	The Ward patent discloses that the housing includes "a plurality of elongate rigid straps." (Ex. B, p. 2, lns. 24-26.) The rigid straps could be made of aluminum. Also, aluminum housings are well known in the art and have been used for years. (*See e.g.*, Ex. E, col. 5, lns. 35-41; Ex. D, col. 3, lns. 59-62; Ex. F, p. 97.)
'618 Patent Claim 7	
7. A light assembly according to claim 6, wherein said support structure is mechanically coupled to said at least one generally fire resistant material and said light fixture.	The Ward patent discloses that "studs or rivets 16 pass through the adjoining surfaces of the straps, the hood and the reflector." (Ex. B, p. 4, lns. 22-25, Figure 1.)
'618 Patent Claim 10	
10. A light assembly according to claim 1, further comprising a junction box adapted to be electrically connected to said light	The Ward patent discloses a "casing for housing electrical connections for connecting the downlighter to a source of mains electricity." (Ex. B, p. 2, lns. 5-6.) It is also obvious to use a junction box in connection with a light fixture. (*See* Ex. D, Figure 1; Ex. E, col. 3, lns. 34-41;

fixture.	Ex. F, p. 97.)
'618 Patent Claim 11	
11. A light assembly according to claim 10, further comprising at least one conduit extending from said junction box, and being capable of electrically coupling said light fixture to at least one other light fixture.	It is obvious to use conduit connected to a junction box to couple the light fixture to another light fixture. (*See* Ex. C, Figure 1; Ex. F, p. 97.)
'618 Patent Claim 12	
12. A light assembly according to claim 10, wherein said junction box is located within said housing.	It is obvious to include the junction box inside the housing. (Ex. C, Figure 1.)
'618 Patent Claim 13	
13. A light assembly according to claim 1, further comprising an attachment member connected to said housing, and being configured to attach said light assembly to said structure.	The Ward patent discloses "flexible clip[s] 8 to assist location of the downlighter within the ceiling space." (Ex. B, p. 3, lns. 24-25.)
'618 Patent Claim 14	
14. A light assembly according to claim 13, wherein said attachment member includes a bar hanger.	Bar hangers have been used for at least the last twenty years in the lighting industry. (*See e.g.*, Ex. D, Figure 1; Ex. G, col. 3, lns. 4-12.) The use of bar hangers to attach the light assembly was an obvious design choice.
'618 Patent Claim 15	
15. A light assembly according to claim 1, wherein said housing is substantially cylindrical.	The Ward patent discloses that the housing can be substantially cylindrical. (Ex. B, Figure 1.)

'618 Patent Claim 16	
16. A method of installing a light assembly comprising the steps of forming a preassembled integral light unit including a lamp fixture and a housing substantially surrounding the lamp fixture, the housing including a generally fire-resistant material, and installing the integral light unit behind an opening in a surface of an adjacent structure, the housing forming a substantially continuous surface with the surface of the adjacent structure.	*See* claim 1. *See also* Ex. B, p. 1, lns. 1-2 ("This invention relates to electric light fittings suitable for mounting within a ceiling space of a building.").
'618 Patent Claim 17	
17. A method according to claim 16, wherein the forming step includes forming the preassembled integral light unit to include a support structure having an exterior surface and an interior surface.	The Ward patent discloses "a plurality of elongate relatively rigid straps" that have an exterior surface and an interior surface. (Ex. B, p. 3, lns. 22-24, Figure 1.)
'618 Patent Claim 20	
20. A recessed light fixture comprising: a light fixture adapted to be installed behind a surface of an adjacent structure; and a housing substantially surrounding said light fixture, such that said housing and said light fixture form a preassembled integral unit, said housing including a first and a second layer, at least one of said first layer and said second layer being formed from a generally fire-resistant	*See* claims 1 and 16. Furthermore, the Ward patent discloses a housing with multiple layers including the protective hood, the intumescent fire proofing material (one or two layers) and the plurality of rigid straps. (Ex. B, Figure 1, p. 2, lns. 17-19, p. 4, lns. 1-4, 24-26.)

material, and at least one of said first layer and said second layer being adapted to form a substantially continuous surface with the surface of the adjacent structure when installed therebehind.	
'618 Patent Claim 21	
21. A recessed light fixture according to claim 20, wherein said first layer forms an interior layer and said second layer forms an exterior layer.	The Ward patent discloses that one layer forms an interior layer and a second layer forms an exterior layer. *See* claim 16, *supra*.

B. 1991 UL Fire Resistance Directory Anticipates And/Or Renders Obvious Claims 1-4, 6-7, 10-17, and 20-21

Underwriter Laboratories' 1991 Fire Resistance Directory discloses that for fire protection a five-sided enclosure (*i.e.*, a housing) made out of gypsum wallboard can be constructed and attached to recessed light fixtures prior to installation in the ceiling. (Ex. D, p. 78 n.14 ("The top and side pieces are laid in place, and the end pieces are secured to the edges of the side and end pieces with 6d nails at each corner.").) The '618 patent states that "examples of generally fire-resistant materials, include, but are not limited to, dry wall or wallboard (*e.g.*, sheet rock, polyamid, asbestos cement sheets, gypsum plasterboard, laminated plastics, etc.), and plaster." (Ex. A, col. 2, lns. 33-37.) The 1991 UL publication also discloses that spacers between the fire resistant housing and light fixture should be used so that the proper clearance is maintained. (*Id.* ("The five-sided enclosure consists of a 24 by 48 in. top piece, two 41/2 (or wider) by 48 in. side pieces, two 6 (or wider) by 24 in. end pieces, and two 6 by 6 in. spacers to maintain a 5/8 in. clearance between the light fixture housing and the top piece.").) This

disclosure makes it clear that the housing and light fixture are assembled prior to installation.

The 1991 UL publication anticipates or renders obvious, alone or in combination with other references, claims 1-4, 6-7, 10-17 and 20-21 of the '618 patent.

C. Claims 1-4, 6-7, 10-17, and 20-21 Are Obvious

The Examiner rejected most of the claims in the application in view of the Monson patent in the June 1, 2004, Office Action. During prosecution of the '618 patent, the applicants also admitted that the prior art Monson patent (Exhibit C) anticipated the claims of the '618 patent except for the housing and light fixture being a pre-assembled integral unit. (Ex. H, September 16, 2004 Interview Summary ("Agreement was reached...since the application was distinguished from Monson because of the limitation of the 'housing and light fixture forming a preassembled integral unit.'").) However, several prior art references cited herein disclose exactly that feature. Accordingly, the claims of the '618 patent are obvious in view of the Monson patent, in combination with those additional references, as explained in detail below.

The Ward patent (Exhibit B) discloses a housing that includes intumescent fire-proofing material and light fixture that are a pre-assembled integral unit. The specification of the Ward patent states that "[t]he present invention sets out to provide a downlighter which includes an integral protective hood..." (Ex. B, p. 2, lns. 1-3.) The integral lighting fixture and protective hood described by the Ward patent seeks to eliminate many of the disadvantages of prior art lighting fixtures, including difficulties with "alignment of a cover with respect to a downlighter" and "fixing a cover to a ceiling..." (Ex. B, p. 1, lns. 16-20.) Thus, the Ward patent not only discloses a

preassembled integral housing with fire proofing material and light fixture, it specifically teaches the benefits and reasons for doing so.

The 1991 UL publication (Exhibit D) discloses a five-sided enclosure made out of gypsum wallboard that is constructed and attached to recessed light fixtures prior to installation in the ceiling. (Ex. D, p. 78 n.14.) The 1991 UL publication discloses that spacers between the fire resistant housing and light fixture should be used so that the proper clearance is maintained. (*Id.* ("The five-sided enclosure consists of a 24 by 48 in. top piece, two 41/2 (or wider) by 48 in. side pieces, two 6 (or wider) by 24 in. end pieces, and two 6 by 6 in. spacers to maintain a 5/8 in. clearance between the light fixture housing and the top piece.").) This disclosure makes it clear that the housing and light fixture form a pre-assembled integral unit prior to installation.

The Montanez patent (Exhibit E) discloses "an enclosure for a recessed ceiling lighting fixture." (Ex. E, col. 1, lns. 48-49.) The Montanez patent further discloses that "the front and back panels 96 and 98 are attached to the side covers 92 that are, in turn, attached to the frame member 12." (Ex. E., col. 5, lns. 47-51.) Thus, the Montanez patent discloses a lighting fixture and an enclosure (*i.e.*, a housing) pre-assembled as an integral unit.

Hubbell's own 1992 Buyer's Guide (Exhibit F, p. 97) discloses a housing for a downlighting fixture where the housing and the fixture are depicted as a preassembled integral unit. (*See, e.g.*, Ex. F, p. 97.)

The Wenman patent discloses a light fixture reflector and socket with a fire-resistant shroud (*i.e.*, housing). (Exhibit H, col. 3, ln. 53 – col. 4, ln. 28.) The light

fixture reflector, socket and fire resistant housing form a pre-assembled integral unit. (Id.)

Each of the above-identified prior art references discloses a housing and a lighting fixture forming a pre-assembled integral unit. Thus, each of these references provides the only information that the applicants identified as missing from the Monson patent. The Ward patent expressly teaches one of skill in the art to form an integral housing with fire proofing material and light fixture. In addition, each of these references (and the Monson patent) are from the same field as the '618 patent, and each addresses the same problem as the '618 patent. Therefore, one of ordinary skill in the art would be motivated to combine one or more of these references with the Monson patent, rendering the claims of the '618 patent obvious. *See Brown & Williamson Tobacco Corp. v. Philip Morris, Inc.*, 229 F.3d 1120, 1125 (Fed. Cir. 2000) (teaching, suggestion or motivation to combine "may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved."). Accordingly, each of these references, in combination with the Monson patent (or other prior art references), raises a substantial new question of patentability of claims 1-4, 6-7, 10-17 and 20-21 of the '618 patent.

V. SUMMARY

The prior art documents referred to herein were not of record in the file of the '618 patent, except for the Monson patent, which is in a new light, and applied in a different way, *i.e.*, in combination with other, newly-cited prior art. *See* § 2642(II), Manual of Patent Examining Procedure, 8th Ed., Rev. 3, p. 2600-44 to 2600-45. Because claims 1-4, 6-7, 10-17 and 20-21 in the '618 patent are not patentable over these prior art documents, a substantial new question of patentability is raised. These

prior art documents provide teachings not provided during prosecution of the '618 patent. For the stated reasons, Genlyte respectfully submits that there exists a substantial new question of patentability of original claims 1-4, 6-7, 10-17 and 20-21 of the '618 patent. Moreover, the claims appear to clearly be anticipated by at least the patents cited herein, and rendered obvious by the cited prior art in view of other prior art of record. As such, it is requested that the Commissioner issue a ruling canceling the claims of the '618 patent.

VI. CERTIFICATION OF SERVICE ON PATENT OWNER

The undersigned certifies that a complete copy of this Request For *Inter Partes* Reexamination has been served via First Class Mail on the attorney of record for the patent owner and the attorneys who are acting as counsel to the patent owner in litigation involving the '618 patent,

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William Y. Klett, III
Nexsen Pruet, LLC
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in compliance with 37 C.F.R. 1.33(c).

Respectfully Submitted,

DATE: January 23, 2006

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